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10/822,883

04/13/2004

Kenneth Merdan

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CROMPTON, SEAGER & TUFTE, LLC
1221 NICOLLET AVENUE
SUITE 800
MINNEAPOLIS, MN 55403-2420

EXAMINER

ELVE, MARIA ALEXANDRA

ART UNIT

PAPER NUMBER

1725

MAIL DATE

DELIVERY MODE

10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,883

Applicant(s)

MERDAN ET AL.

Examiner

M. Alexandra Elve

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1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 7/16/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the debris is kept away from the laser.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, 11-16, 18-19, 21-23 & 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al. (USPN 5,855,802) in view of Pacetti et al. (USPN 6,695,920).

Acciai et al. discloses a method and apparatus for forming a tubular article having a perforated annular wall, such as a surgical stent. Figure 3 shows a laser (40), a fiber optic (44), a beam splitter (42) and an optical guide (46). Note that the laser beam moves partially in a horizontal direction in the fiber optic and horizontally in the

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optical guide. The tubular member (32) is mounted in a chuck (34). The laser beams are focused by focusing mirrors (56 & 58) mounted at 45° (tuning mirror). The apparatus is supported by a precision table (66) and a table (68). The tubular member is rotated by a rotating means (36), powered by a rotary drive motor (38). The tubular member is moved in a horizontal (translational) direction by means of a linear drive motor (70). The laser beams (60 & 62) cut the tubular member, in this case a stent.

Acciai et al. does not teach all the elements mounted to one table, the coupling of the linear and rotary motors, the presence of guides, the workpiece below the motor(s), a granite base and a radiopaque workpiece.

Pacetti et al. discloses a mandrel apparatus for supporting a stent. The stent is connected to a rotational motor (24) and another motor (28), which provides linear directional motion (back and forth along a rail). In addition, gears members (22) (guides) and a rail (30) provide guide members.

It would have been obvious to one of ordinary skill in the art at the time of the invention to couple the motor(s) and provide guides (gear members for stent support and rails), as taught by Pacetti et al. in the Acciai et al. system because coupling the motors minimizes manufacturing real estate and guides support components and provides articles for motion.

Making elements integral was held to have been obvious. In re Wolfe 116 USPQ 443. Reversal of parts was held to have been obvious. In re Gazda 104 USPQ 400. Rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70. The type of materials chosen is a choice in design and substitution of known equivalent

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structures (table for granite or radiopaque workpiece) has been held obvious. In re Kuhle 188 USPQ (CCPA 1975), In re Ruff 118 USPQ 343 (CCPA 1958).

Claims 5, 9, 17, 20, 24 & 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acciai et al. and Pacetti et al., as stated above and further in view of Tessier et al. (USPN 5,073,694).

Acciai et al. and Pacetti et al. do not teach the use of coolant in the cutting system.

Tessier et al. discloses laser cutting of a hollow metal workpieces. Coolant is pumped through the apparatus to contact the inner portion of the workpiece before and during laser cutting.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a coolant as taught by Tessier et al. in the Acciai et al. and Pacetti et al. system because it ensures a cleaner finished product.

Making elements integral was held to have been obvious. In re Wolfe 116 USPQ 443. Reversal of parts was held to have been obvious. In re Gazda 104 USPQ 400. Rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70. The type of materials chosen is a choice in design and substitution of known equivalent structures (table for granite) has been held obvious. In re Kuhle 188 USPQ (CCPA 1975), In re Ruff 118 USPQ 343 (CCPA 1958).

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Response to Amendment

The amendment filed 7/16/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the debris is kept away from the laser.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed 7/16/07 have been fully considered but they are not persuasive.

Applicant argues that Acciai et al. and Pacetti et al. do not teach the workpiece below the motors. The examiner respectfully notes that: Reversal of parts was held to have been obvious. In re Gazda 104 USPQ 400. Rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on 571-272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 30, 2007.

/M. Alexandra Elve/
M. Alexandra Elve
Primary Examiner 1725